REMARKS

In response to the rejection under 35 U.S.C. 112, Claim 54 has been amended to address the antecedent basis issue.

Claims 72 and 73 have also been amended in response to the rejection under 35 U.S.C. 112.

Reconsideration of this Application and allowance of the amended claims are respectfully requested. No extra claim filing fee is required for the three added claims in view of the cancellation of claims 6-8 and 17-18.

On page 7, paragraph 3 of the Office Action of January 28, 2004, the Examiner states that claims of this Application recite "a third outcome type that it is a no win outcome type. The instant amended claims do not recite language that describes any type of output for the third outcome type. Therefore, the examiner asserts that this instant claim feature, as currently written, is taught by Walker, et al....".

In order to overcome the rejection, claim 1 has been amended to call for, in the last two lines, "...a no reward output in which there is no monetary prize amount or audiovisual display in response to an outcome of said third outcome type." For support, see page 12 of the Specification, lines 18 and 19.

Turning to the rejection of Claim 1 over Walker, et al. Patent No. 6,234,896 as described in pages 2 and 3 of the last Office Action, Walker, et al. is very clear that all outcomes of the gaming device disclosed therein yield a desirable prize "...which may be a monetary amount, a video presentation segment or a combination thereof." (see the Abstract).

It is submitted that Claim 1 as amended has patentable distinction over Walker, et al. U.S. Patent No. 6,234,896.

Also, it is believed that the claims which are dependent upon Claim 1 are patentable in view of the distinctions of Claim 1, as well as their own distinctions over the prior art.

Independent Claim 32 is also rejected as anticipated by Walker, et al. 6,234,896. Here also, the limitation has been added that there is "...no monetary prize amount or audiovisual display in response to an outcome of said third outcome type."

Accordingly, it is believed that Walker, et al. is distinguished from Claim 32 in a manner similar to the distinctions of Claim 1. The claims which are dependent upon Claim 32 also carry equal distinction.

Turning to independent Claim 49, it also is rejected as anticipated by Walker, et al. 6,234,896. In this claim also, the last three lines now carry the limitation: "... there being no monetary prize amount or audiovisual display comprising a musical recording artist's song in response to an outcome of said third outcome type."

As before, it is believed that Claim 49 and its dependent claims thus provide patentable distinction over Walker, et al.

The Examiner has also rejected claims which are dependant upon the three independent claims discussed above as unpatentable over Walker, et al. 6,234,896 based on 35 U.S.C. 103. Here also, these dependent claims are submitted to share in the patentably distinct limitations of their parent, independent claims, the distinctions of which have been discussed above.

However, turning to the rejection of claims 9, 15, 44, 63, 66, and 69, the Examiner acknowledges that Walker lacks the teaching the video clips are picked at random (page 3 of the Office Action, last paragraph). Those skilled in the art would not find it obvious to modify Walker to use randomly selected video clips. For example, in Walker et al. 6,234,896, at column 3, lines 27-31, it is stated that the network server "...selects a video presentation for each respective slot machine based on the player data and payout parameters."

This is clearly an entirely non-random selection, since it is based on the player data (i.e. a selection of a video presentation that is expected to please the individual player). Similarly, the non-cash payouts in Walker, et al. may comprise segments of a longer video, which then may be viewed sequentially, play by play, as the player plays the game (column 5, line 59 – column 6, line 20). This sequential playing of portions of a video is the exact opposite of a random selection of a video clip. Accordingly, those having Walker, et al. before them would not be led to the random selection of a video clip as called for in Claims 9, 15, 44, 63, 66 and 69. A randomly selected audiovisual presentation can be very useful because a predictable, audiovisual presentation may get boring, resulting in less player drawing power for the game.

With respect to the rejection of Claims 10, 16, 35, 65, 68, 71, and 51, the Examiner acknowledges that Walker lacks the teaching of player (or operator) selection of the video clip.

It is submitted that the concept of player selection is by no means obvious in view of the disclosure of Walker, in which the disclosure is limited to the clearest teaching that the software of the machine itself does the selection of the video clip to be

presented. It is submitted this would lead away from any modification of the type that the Examiner suggests.

The Examiner has also rejected numerous claims, and particularly independent Claim 54 and its dependent claims, as unpatentable over Walker, et al. 6, 234,896 in view of Acres, et al. U.S. Patent No. 5,752,882.

However, even if a progressive prize as taught by Acres were deemed to be an obvious modification of Walker, et al., Claim 54 includes the limitation "...further comprising an input device which permits a player to select from among said series of graphics, images, motion pictures or other video clips...".

As the Examiner acknowledges, the selection by a player of such graphics, images, motion pictures, or other video clips is not taught in Walker et al., nor is it taught in Acres et al. While it is true that it is known in the art for the players to select particular parameters, it is submitted that the specific concept of the invention is not obvious: i.e. a reward of a visual image of some sort, the awarding of which "...is controlled in response to said first output." (Claim 54, last two lines). The Examiner refers at the top of page 7 of the Office Action to the obviousness of allowing players to select a game from a plurality of video clip games, but that is a very different thing from the selection of a video visual award, made available by a winning outcome in a game.

In view of the above, allowance of the claims is respectfully requested.

Also, by an information disclosure statement of January 21, 2004, applicant's attorney made of record U.K. Patent Application GB 2072 395 A, which was cited on December 5, 2003 in the prosecution of the corresponding European patent application.

The Examiner is requested to consider this reference and to acknowledge the same by returning an initialed copy of the list of references cited by Applicant.

Also, Applicant's attorney also wishes to make of record PCT Application W098/40141, and Marnell U.S. Patent No. 5,259,613. These references were recently cited in the corresponding Canadian application. A PTO Reference Citation form is enclosed, along with copies of the cited references. Also, the four patent references cited in the first paragraph of this Application are included.

Respectfully submitted,

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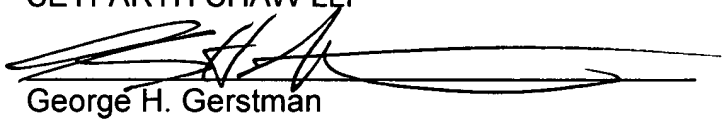

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